

#14 *QRE*  
Docket No. HRT0279

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Boyd et al.  
Serial No. : 09/982,502 Art Unit : 3738  
Filed : October 18, 2001 Examiner : D. Isabella  
Title : Devices & Methods for Port-Access Multivessel Coronary  
Artery Bypass Surgery

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Commissioner of Patents, P.O. Box 1450, Alexandria VA 22313-1450 on

January 12, 2004  
(Date of Deposit)

Brian S. Tomko  
(Name of applicant, assignee, or Registered Representative)

*BS Tomko*  
(Signature)

January 12, 2004  
(Date of Signature)

Honorable Commissioner of Patents  
Mail Stop Petition  
Alexandria, VA 22313

PETITION TO ACCEPT  
AN UNINTENTIONALLY DELAYED CLAIM OF PRIORITY

Dear Sir:

This Petition is made in response to the Office Action dated September 10, 2003, wherein the Examiner rejected all of the pending claims as either anticipated or rendered obvious by a patent having a priority date that is later than the earliest priority that this application is entitled to. The Examiner stated at page 2 of the Office Action that "Applicant's earliest priority dates back to the divisional filed on January 19, 2000", based on the Preliminary Amendment filed when the application was originally filed on October 18, 2001. A copy of the Office Action is attached as Appendix A and a copy of the Preliminary Amendment is attached as Appendix B.

Applicants hereby petition the Commissioner under 37 C.F.R. §1.78(a)(3) to claim the benefit under 35 U.S.C. § 120 of earlier filed applications in the United States. This claim has

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not been previously filed in connection with this application. The correct claim of priority is described below.

This application is a divisional of U.S. Patent Application Serial No. 09/487,024, filed January 19, 2000, now issued as U.S. Patent No. 6,494,211, which is a continuation of U.S. Patent Application Serial No. 09/019,014, filed February 5, 1998 now abandoned, which is a division of U.S. Patent Application Serial No. 08/486,941, filed June 7, 1995, now U.S. Patent No. 5,799,661, which is a continuation-in-part of U.S. Patent Application Serial No. 08/281,891, filed July 28, 1994, now U.S. Patent No. 5,735,290, which itself is a continuation-in-part of copending U.S. Patent Application Serial No. 08/023,778, filed February 22, 1993 now U.S. Patent No. 5,452,733.


The entire delay between the date the priority claim was due under paragraph §1.78(a)(2)(ii), four months from the actual filing date of this application (October 18, 2001), and the date the priority claim was made (January 12, 2004, the date on which this Petition is mailed), was unintentional. When the current application was filed, priority was claimed to the prior pending application (Serial No. 09/487,024, filed on January 19, 2000), as is shown in box 18 of the Transmittal Sheet dated October 18, 2001, attached as Appendix C. The first page of the specification of the filed application included a related applications paragraph, which listed a claim to priority to the two earliest related applications in the chain listed above (Serial No. 08/281,891, filed on July 28, 1994, and Serial No. 08/023,778, filed on February 22, 1993). The Preliminary Amendment filed on October 18, 2001, failed to amend the related applications paragraph to include the related applications filed between the parent application and the two earliest related applications.

Applicants's undersigned representative first became aware of the need to update the priority statement when preparing to respond to the outstanding Office Action (Appendix A). Upon reviewing the pending Office Action (Appendix A) on December 10, 2003, the undersigned became aware of the need to petition to claim priority and promptly filed this Petition within one month.

Please charge the surcharge set forth in 37 CFR § 1.17(t) of \$1,330.00 to Account 10-0750/HRT-279/BST and any additional surcharge or fee that is required in connection with this petition.

Please feel free to contact me, if anything further is required at (732)524-1239.

Respectfully submitted,

By:   
\_\_\_\_\_  
Brian S. Tomko  
Reg. No. 41,349

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-1239  
(732) 524-5575 (fax)  
Dated: January 12, 2004

APPENDIX A



## Office Action Summary

Application No.

09/982,502

Applicant(s)

BOYD ET AL.

Examiner

DAVID J ISABELLA

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 18,20 and 26-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

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Art Unit: 3738

***Election/Restrictions***

Claims 18,20 and 26-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 12.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,19,21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Benetti, et al (5894843).

Applicant's earliest priority dates back to the divisional filed on 1/19/00. The claimed subject matter was not disclosed in the CIP 08/281891 and the CIP 08/023778.

Benetti et al discloses a method for cardiac surgery on a heart comprising the steps of making at least one access port into the chest through an intercostals space where a first aspect of the heart faces the access port and the second aspect of the heart faces away from the port. The surgical method includes the introduction of a retraction instrument through the port, manipulating the instrument to reposition the heart into a retracted position while the ribs and sternum remains intact.

Claims 2-3,5-6,19,21,22,23,24,25 see columns 3 and 7.

Art Unit: 3738

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al (5894843) as applied supra.

Benetti, et al does not disclose the specific target arteries and by pass. Examiner contends that the various methods of bypass utilizing the different vessels is well known in the art and does not form the basis of this invention. Examiner maintains that the various bypass procedures, if not inherent, in Benetti, et al would have been obvious to one with ordinary skill in the art as these procedures are routinely performed in surgical procedures with radical sternotomy. The minimal intrusion of the intercostals opening is a means for preventing the radical approach of cutting the sternum. Albeit, once the heart cavity is exposed to the surgeon by the intercostals approach, all routine bypass employed by the sternotomy would be available to the surgeon using the intercostals procedures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax

Art Unit: 3738

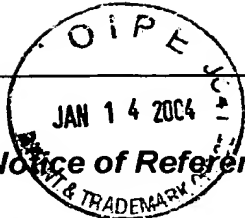
phone number for the organization where this application or proceeding is assigned is  
(703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is 703-308-  
0858.



DAVID J ISABELLA  
Primary Examiner  
Art Unit 3738

dji

**Notice of References Cited**Application/Control No.  
09/982,502Applicant(s)/Patent Under  
Reexamination  
BOYD ET AL.Examiner  
DAVID J ISABELLAArt Unit  
3738

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,894,843	04-1999	Benetti et al.	128/898
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office  
PTO-892 (Rev. 01-2001)**Notice of References Cited**

Part of Paper No. 13

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APPENDIX B

Docket No. HRT-0279

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Stephen W. Boyd et al.  
Serial No. : 09/982,502 Art Unit : 3738  
Filed : 10/18/2001 Examiner :  
Title : Devices and Methods for Port-Access Multivessel Coronary Artery Bypass Surgery

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231 on

1/8/02  
(Date of Deposit)

Brian S. Tomko  
(Name of applicant, assignee, or Registered Representative)

  
(Signature)

1/8/02  
(Date of Signature)

Honorable Commissioner of Patents  
Washington, D.C. 20231

PRELIMINARY AMENDMENT

Dear Sir:

This is a Preliminary Amendment for the Divisional Patent Application filed on October 18, 2001 which is a Divisional of prior pending application Serial No. 09/487,024 filed on January 19, 2000. The prior Preliminary Amendment filed on October 18, 2001 incorrectly identified the canceled claims.

In the Claims:

Please cancel, without prejudice, Claims 45-149.

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REMARKS/ARGUMENTS

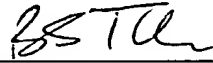
This is a Preliminary Amendment for the above-identified Divisional Patent Application filed on October 18, 2001, which is a Division of commonly assigned, copending patent application Serial No. 09/487,024. Applicants have canceled without prejudice claims 45-149. Remaining claims 1-44 correspond to the Examiner's Group I contained in the Restriction Requirement in the parent application.

In the Restriction Requirement of the parent application, the Examiner required that, if Group I was chosen, Applicants should elect a species "between vacuum, loop and rigid finger". Applicants traverse the election of species. Claims 1-17 and 21-28 do not require either a vacuum, loop or rigid finger, and are therefore generic to all three species. Claims 18 and 29-44 claim a method that includes the step of applying vacuum. Claim 19 claims a method that includes the step of lifting the heart with a rigid finger and claim 20 claims a method of placing a flexible loop around the heart.

To comply with the requirements of 35 USC 121, Applicants elect the species readable on the vacuum limitation, which includes claims 1-18 and 21-44. In the event that a discussion would clarify this issue, the Examiner is invited to telephone Applicants' representative at his or her convenience.

Respectfully submitted,

By: \_\_\_\_\_

  
Brian S. Tomko  
Reg. No. 41,349

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-1239  
Dated: January 8, 2002

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APPENDIX C

<b>UTILITY PATENT APPLICATION TRANSMITTAL</b>  <small>(only for new nonprovisional applications under 37 CFR 1.53(b))</small>	Attorney Docket No.	HRT-279
	First Inventor	Stephen W. Boyd et al.
	Title	Devices and Methods for Port-Access Multivessel Coronary Artery Bypass Surgery
	Express Mail Label No.	EL691443617US

<b>APPLICATION ELEMENTS</b> <small>See MPEP Chapter 600 concerning utility patent application contents.</small>	<b>ADDRESS TO:</b> Commissioner for Patents Box Patent Application Washington, DC 20231
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1. <input checked="" type="checkbox"/> Fee Transmittal Form (e.g., PTO/SB/17) <small>(submit an original and a duplicate for fee processing)</small> 2. <input type="checkbox"/> Applicant claims small entity status. 3. <input checked="" type="checkbox"/> Specification [Total Pages 64] <small>(Preferred arrangement set forth below)</small> - Descriptive Title of the Invention - Cross Reference to Related Applications - Statement Regarding Fed sponsored R&D - Reference to sequence listing, a table, or a computer program listing appendix - Background of the Invention - Brief Summary of the Invention - Brief Description of the Drawings (if filed) - Detailed Description - Claim(s) - Abstract of the Disclosure 4. <input checked="" type="checkbox"/> Drawing(s) (35 USC 113) [Total Sheets 36] 5. Oath or Declaration [Total Pages 5] a. <input type="checkbox"/> Newly executed (original or copy) b. <input checked="" type="checkbox"/> Copy from a prior application (37 CFR 1.63(d)) <small>(for continuation/divisional with Box 18 completed)</small> i. <input type="checkbox"/> <b>DELETION OF INVENTOR(S)</b> Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b). 6. <input type="checkbox"/> Application Data Sheet. See 37 CFR 1.76	7. <input type="checkbox"/> CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix) 8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary) a. <input type="checkbox"/> Computer Readable Form (CRF) b. <input type="checkbox"/> Specification Sequence Listing on: i. <input type="checkbox"/> CD-ROM or CD-R (2 copies); or ii. <input type="checkbox"/> paper c. <input type="checkbox"/> Statement verifying identity of above copies  <b>ACCOMPANYING APPLICATION PARTS</b> 9. <input type="checkbox"/> Assignment Papers (cover sheet & document(s)) 10. <input type="checkbox"/> 37 CFR 3.73(b) Statement <input type="checkbox"/> Power of Attorney <small>(when there is an assignee)</small> 11. <input type="checkbox"/> English Translation Document (if applicable) 12. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations 13. <input type="checkbox"/> Preliminary Amendment 14. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) <small>(Should be specifically itemized)</small> 15. <input type="checkbox"/> Certified Copy of Priority Document(s) <small>(if foreign priority is claimed)</small> 16. <input type="checkbox"/> Request and Certifications under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent. 17. <input type="checkbox"/> Other
--	--

18. ☒ If a CONTINUING APPLICATION, check appropriate box and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-Part (CIP) of prior application No.: 09/487,024, filed 01/19/00.

Prior application information: Examiner D. Isabella      Group Art Unit: 3738

For CONTINUATION or DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

☒ Customer Number or Bar Code Label **000027777** or ☐ Correspondence Address below

Name: Philip S. Johnson, Esq.  
 Address: Johnson & Johnson  
 One Johnson & Johnson Plaza  
 New Brunswick, NJ 08933-7003 USA

20. TELEPHONE CONTACT

Please direct all telephone calls or telefaxes to E. Richard Skula at:  
 Telephone: (732) 524-2718      Fax: (732) 524-2808

21. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

NAME	E. Richard Skula	Reg. No. 31061
SIGNATURE		
DATE	October 18, 2001	

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